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09/532,937	03/22/2000	Stefan Georg Hild	RSW9-99-132	9182
75	90 06/21/2004		EXAMINER	
A Bruce Clay			ENGLAND, DAVID E	
IBM Corporation Dept T81/062 3039 Comwallis Road			ART UNIT	PAPER NUMBER
RTP, NC 2770			2143 DATE MAILED: 06/21/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

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	Application No.	Applicant(s)	A.		
	09/532,937	HILD ET AL.	$\mathcal{A}$		
Office Action Summary	Examiner	Art Unit			
	David E. England	2143			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the	correspondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period w Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	36(a). In no event, however, may a reply be ti within the statutory minimum of thirty (30) da will apply and will expire SIX (6) MONTHS from cause the application to become ABANDON	mely filed ys will be considered timely. n the mailing date of this communic ED (35 U.S.C. § 133).	ation.		
Status					
1) Responsive to communication(s) filed on 29 M	arch 2004.				
2a)⊠ This action is <b>FINAL</b> . 2b)□ This	action is non-final.				
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is					
closed in accordance with the practice under E	Ex parte Quayle, 1935 C.D. 11, 4	.53 O.G. 213.			
Disposition of Claims					
<ul> <li>4)</li></ul>	wn from consideration.  nd 36 – 44 is/are rejected.	application.			
Application Papers					
9)☐ The specification is objected to by the Examine 10)☒ The drawing(s) filed on 22 March 2000 is/are:  Applicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11)☐ The oath or declaration is objected to by the Ex	a) accepted or b) objected drawing(s) be held in abeyance. Se ion is required if the drawing(s) is o	ee 37 CFR 1.85(a). bjected to. See 37 CFR 1.12	• •		
Priority under 35 U.S.C. § 119					
12) Acknowledgment is made of a claim for foreign a) All b) Some * c) None of:  1. Certified copies of the priority document: 2. Certified copies of the priority document: 3. Copies of the certified copies of the priority application from the International Bureau * See the attached detailed Office action for a list	s have been received. s have been received in Applica rity documents have been receiv u (PCT Rule 17.2(a)).	tion No /ed in this National Stage			
Attachment(s)	_				
1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date	4) Interview Summar Paper No(s)/Mail I 5) Notice of Informal 6) Other:				

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### **DETAILED ACTION**

1. Claims 1,2 5 – 12, 15 – 22, 25 – 30, 32, 34 and 36 – 44 are presented for examination.

## Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

- 2. Claim 21 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
- 3. The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).

- 4. Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties <u>being less than all available client properties</u> found in the original discloser of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.
- 5. Claims 37, 40 and 43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
- 6. The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).
- 7. Specifically, there is no support in the original disclosure of the teachings of a plurality of requested client properties included in the list in the link element <u>are less than all client properties</u> that may be included in the list is found in the original discloser of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.

- 8. Claims 38, 41 and 44 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
- 9. The claims is rejected under 35 U.S.C. 112, first paragraph as failing to comply with the description requirement thereof since the claims introduce new matter not supported by the original disclosure. The original disclosure does not reasonably convey to a designer of ordinary skill in the art that applicant was in possession of the design now claimed at the time the application was filed. See *In re Daniels*, 144 F.3d 1452, 46 USPQ2d 1788 (Fed. Cir. 1998); *In re Rasmussen*, 650 F.2d 1212, 211 USPQ 323 (CCPA 1981).
- 10. Specifically, there is no support in the original disclosure of the teachings of a inserted at least one of said plurality of client properties <u>is less than all the plurality of requested properties</u> included in the link element is found in the original discloser of the specification. Therefore, new subject matter will not be entered and the previous rejection still stands as restated below.
- Claims 9, 19 and 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The limitation of, "transmitting the request without at least one of the selected

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ones of the plurality of request client properties <u>if the user indicates the selected ones of</u> the plurality of requested client properties are not to be sent", is not specifically found in the specification. The Applicant is suggested to add the missing step that states that the client properties are not mandatory. This would narrow the scope of the claim and would require further search and consideration **but** would overcome the rejection stated above.

## **Drawings**

12. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the a plurality of requested client properties being less than all available client properties must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

13. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

- 14. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
- 15. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the inserted at least one of said plurality of client properties is less than all the plurality of requested properties included in the link element must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.
- 16. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### Claim Rejections - 35 USC § 102

- 17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
- 18. A person shall be entitled to a patent unless –
- 19. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
- 20. Claims 1, 2, 11, 12, 21 and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Merriman et al. U.S. Patent No. 5948061 (hereinafter Merriman).

- 21. Referencing claim 1, Merriman teaches in a networked environment, a method for designating client properties comprising:
- receiving a link element associated with a server, that link element including a plurality of requested client properties, (e.g. col. 3, line 24 col. 4, line 11 & col. 5, line 33 col. 7, line 43);
- 23. selecting said link element to request a document identified by the link element to be transmitted to a client, (e.g. col. 3, line 24 col. 4, line 11 & col. 5, line 33 col. 7, line 43);
- inserting at least one of said plurality of requested client properties into a request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client properties, (e.g. col. 3, line 24 col. 4, line 11 & col. 5, line 33 col. 7, line 43).
- 25. Referencing claim 2, Merriman teaches said plurality of requested client properties is contained within an attribute of said link element, (e.g. col. 3, line 24 col. 4, line 11).
- 26. Claims 11, 12, 21 and 22 are rejected for similar reasons as stated above.

Claim Rejections - 35 USC § 103

- 27. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
- 28. (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.
- 29. Claims 5, 15, 25, 32, 34 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Gershman et al. (6401085) (hereinafter Gershman).
- 30. As per claim 5, Merriman does not specifically teach said plurality of requested client properties includes at least one property that is a wild card. Gershman teaches said plurality of requested client properties includes at least one property that is a wild card, (e.g. col. 21 22). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because it would be more efficient for a user to utilize this very common utility as a wild card, (i.e. \*.doc, hyper\$ism, ect.), to broaden a field of search.
- As per claim 34, Merriman does not specifically teach at least one of the plurality of requested client properties is associated with hardware characteristics of the client.

  Gershman teaches at least one of the plurality of requested client properties is associated with hardware characteristics of the client, (e.g. col. 58, lines 21 29). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because having hardware as at least one requested client

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property could aid in the transmission, storage and compatibility of the system that is transmitting the client information. For example, if a client wanted to download information after accessing a link and the user didn't have a fast enough transmission median, the server from which the download is coming from would know this from the transmitted hardware information that was requested from the client, therefore the server could make the necessary changes to make sure that the download transmits successfully without error or deny the client altogether.

- 32. Claims 14, 15, 24, 25, 34 and 36 are rejected for similar reasons as stated above.
- 33. Claims 6, 7, 16, 17, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn et al. (6098081) (hereinafter Heidorn).
- 34. As per claim 6, Merriman teaches all that is similar with reference to claim 1 but does not specifically teach said plurality of requested client properties includes at least one property that is designated as a mandatory property and at least one property that is an optional property. Heidorn teaches said plurality of requested client properties includes at least one property that is designated as a mandatory property and at least one property that is an optional property, (e.g. col. 7, lines 18 27, "link bound attributes and mandatory attributes"). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because it would be more

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efficient for a system to have at least one property that the system could use to identify a user. If there is no property for a user then the user does not exist in the system.

- 35. As per claim 7, Merriman does not specifically teach said step of inserting comprises the steps of:
- 36. selecting each one property from said plurality of requested client properties included in the link element; and
- 37. determining whether said each one property is available to be transmitted. Heidorn teaches said step of:
- 38. inserting comprises the steps of selecting each one property from said plurality of requested client properties included in the link element, (e.g. col. 3, line 56 col. 4, line 34, "soft hyperlink"); and
- 39. determining whether said each one property is available to be transmitted, (e.g. col. 3, line 56 col. 4, line 34). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn with Merriman because it would be more efficient if the system error check to see if the system or user had specific property data to transmit to the system. If the system didn't have this function it could cause error in the system and build a property list or table that has incorrect property information about a user making the system flawed.
- 40. Claims 16, 17, 26 and 27 are rejected for similar reasons as stated above.

- 41. Claims 8, 18 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Gershman (6401085).
- 42. As per claim 8, Merriman and Heidorn do not specifically teach said step of selecting further comprises expanding a wildcard property. Gershman teaches said step of selecting further comprises expanding a wildcard property, (e.g. cols. 21 22). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman and Heidorn because it would be more efficient for the system to be able to utilize the function of a wild card, (i.e. the ability of have a symbol to stand for different files and/or letters).
- 43. Claims 18 and 28 are rejected for similar reasons as stated above.
- Claims 9, 19, 29, 39, 42 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Gershman (6401085) in further view of Bruck et al. (6268856) (hereinafter Bruck).
- 45. As per claim 9, as closely interpreted by the Examiner, Merriman does not specifically teach prompting a user whether to transmit the selected ones of the plurality of requested client properties if it is determined that at least one of the selected ones of the plurality of requested client properties is available to be transmitted; and

- transmitting the request without at least one of the selected ones of the plurality of request client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent.
- Heidorn teaches said step of determining further comprises prompting to transmit said each one property, (e.g. col. 3, line 56 col. 4, line 34 & col. 7, lines 18 27), but does not teach said step of determining further comprises prompting a user whether to transmit. Gershman teaches said step of determining further comprises prompting a user whether to transmit, (e.g. col. 3, lines 14 29 & col. 43, line 45 col. 44, line 14). Bruck teaches if it is determined that at least one of the selected ones of the plurality of requested client properties is available to be transmitted, (e.g. col. 10, lines 51 67 & col. 13, lines 29 49); and
- transmitting the request without at least one of the selected ones of the plurality of request client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent, (e.g. col. 10, lines 51 67 & col. 13, lines 29 49). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman, Heidorn and Bruck with Merriman because make a system have more versatility for a user that would want to utilize the system but would not want to divulge certain information that would be considered private and/or vital to a user, (i.e. cookies that might have credit card information, social security number). Having this option would make a user more likely to utilize the invention for it security reasons.
- 49. Claims 19, 29, 39, 42 and 45 are rejected for similar reasons as stated above.

- 50. Claims 10, 20 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Heidorn (6098081) in further view of Bruck (6268856).
- 51. As per claim 10, as closely interpreted by the Examiner, Merriman does not specifically teach
- 52. terminating the request if it is determined that at least one of the selected ones of the plurality of requested client properties is not available to be transmitted and the at least one of the selected ones of the plurality of requested client properties that is not available to be transmitted is a mandatory property. Bruck teaches determined that at least one of the selected ones of the plurality of requested client properties is not available to be transmitted, (e.g. col. 10, lines 51 67 & col. 13, lines 29 49).
- Heidorn teaches the step of terminating the request if a mandatory property and an optional property are not available to be transmitted, (e.g. col. 3, line 56 col. 4, line 34, "link bound attributes and mandatory attributes"). It would have been obvious to one skilled in the art at the time the invention was made to combine Heidorn and Bruck with Merriman because of similar reasons stated above. Furthermore, if the user didn't have the information that is mandatory for the system to function then the system would not be able to execute its functions therefore, making the inventions function useless.
- 54. Claims 20 and 30 are rejected for similar reasons as stated above.

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55. Claims 37, 38, 40, 41, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merriman (5948061) in view of Gershman (6401085).

- As per claim 37, Marriman does not specifically teach the plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list. Gershman teaches the plurality of requested client properties included in the list in the link element are less than all client properties that may be included in the list, (e.g. col. 46, lines 44 60, "and discarding the less relevant ones"). It would have been obvious to one skilled in the art at the time the invention was made to combine Gershman with Merriman because discarding the less relevant interests provides an increase in the quality of the document.
- 57. Claims 38, 40, 41, 43 and 44 are rejected for similar reasons as stated above.

#### Response to Arguments

- 58. Applicant's arguments filed 03/29/2004 have been fully considered but they are not persuasive.
- 59. In the remarks, Applicant argues in substance that nothing in the cited portion of Merriman discloses or suggests receiving a link element from the server including a plurality of requested client properties, inserting at least one of these requested client

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properties into a request and using the at least one requested client properties to customize the requested document.

- 60. As to part 1, Examiner would like to draw the Applicant's attention to column 5, lines 45 49 of Merriman. In which, Merriman discussed the use of a promotional advertisement to a new user to gather information about him or herself. Once the user selects an advertisement to view, (a link element), information about the user is gathered because of the type of advertisement that is presented and from other advertisements gathered by the system. This can be interpreted in to the broad limitations of claims 1, 11, and 21.
- 61. Furthermore, when reviewing a reference the applicants should remember that not only the specific teachings of a reference but also reasonable inferences which the artisan would have logically drawn therefrom may be properly evaluated in formulating a rejection. In re Preda, 401 F. 2d 825, 159 USPQ 342 (CCPA 1968) and In re Shepard, 319 F. 2d 194, 138 USPQ 148 (CCPA 1963). Skill in the art is presumed. In re Sovish, 769 F. 2d 738, 226 USPQ 771 (Fed. Cir. 1985). Furthermore, artisans must be presumed to know something about the art apart from what the references disclose. In re Jacoby, 309 F. 2d 513, 135 USPQ 317 (CCPA 1962). The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference. In re Bozek, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). Every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein. In re Bode, 550 F. 2d 656, 193 USPQ 12 (CCPA 1977).

- 62. In the remarks, Applicant argues in substance that none of the cited references either alone or in combination disclose or suggest the recitations of at least the dependent claims set out above. Furthermore, the motivation is a motivation based on "subjective belief and unknown authority", the type of motivation that was rejected by the Federal Circuit in *In re Sang-su Lee*. The Office Action does not point to any specific portion of the cited references that would induce one of skill in the art to combine the cited references as suggested in the Office Action.
- As to part 2, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
- 64. In the remarks, Applicant argues in substance that the limitation of a plurality of requested client properties being less than all available client properties is disclosed in the specification. More specifically, "...a method by which a Web server can indicate which device, user, software, and network properties can it use when generating personalized content for the requesting user.", "can indicate which device, user

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software, and network <u>properties</u> are required for it to generate any meaningful content for the requesting user...".

- As to part 3, Examiner would like to draw the Applicant's attention to the claim language from which this argument derives from, "plurality of requested client properties being less than all available client properties". In which it is interpreted that the requested client properties have to be less than all available client properties. The cited areas of the Applicant's application indicate that it could use all the network properties that are given to the Web server. Therefore, rejection still stands along with drawing Objections for they also fall under the same reasons as stated above.
- Applicant's arguments with respect to claims 5 10, 12, 15 20, 22, 25 30, 32, 34 and 36 44 have been considered but are moot in view of the new ground(s) of rejection.

## Conclusion

- 67. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
- 68. a. Jawahar et al. U.S. Patent No. 6298356 discloses Methods and apparatus for enabling dynamic resource collaboration.
- 69. b. Kurtzman, II et al. U.S. Patent No. 6144944 discloses Computer system for efficiently selecting and providing information.

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70. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 703-305-5333. The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 703-308-5221. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England Examiner Art Unit 2143

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SUPERVISORY PATENT EXAMINER
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